

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claims 1-15, 20, 22, and 23 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent App. Pub. No. 2002/0018228 to Torigoe ("*Torigoe*").

Claims 1-23 remain pending, and claims 16-19 and 21 have been withdrawn.

Applicants respectfully traverse the rejection of claims 1-15, 20, 22, and 23 under 35 U.S.C. § 102(b) as anticipated by *Torigoe*. In order to properly establish that *Torigoe* anticipates Applicants claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites a image forming device including, for example:

...  
a printing unit for printing the specified mark on a recording element including an IC tag when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job; and  
a writing unit for writing mark information indicating the specified mark's content on the IC tag included in the recording element when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job.

(emphasis added). *Torigoe* does not disclose each and every element of Applicants' claimed invention.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

*Torigoe* discloses an image processing apparatus including a judging means and a control means (paragraph 0023). The Examiner cites paragraph 0040 of *Torigoe* to disclose the claimed "IC tag" (Office Action at page 3). This is not correct.

This passage of *Torigoe* discloses a pattern that "may be an invisible digital watermark for embedding information in a specific frequency of an image, a visible digital watermark for embedding the information by a color invisible to human eyes (e.g., yellow dot), or any other digital watermark." Nothing in passage or any other passage of *Torigoe* teaches or suggests the claimed "IC tag."

The Examiner, therefore, if relying on inherency, must provide extrinsic evidence tending to show inherency. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112(IV), internal citations omitted. Thus,

[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *Id.*

In this case, the Examiner has not provided extrinsic evidence that makes clear the missing descriptive matter is necessarily present in *Torigoe* to satisfy all the elements of independent claim 1. Accordingly, the Examiner's rejection must fail.

Therefore, *Torigoe* does not teach or suggest the claimed combination of elements including, for example, "a printing unit for printing the specified mark on a recording element including an IC tag when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job" and "a writing

unit for writing mark information indicating the specified mark's content on the IC tag included in the recording element when it is judged by said judgment unit that the instruction for adding the specified mark is included in the printing job," as recited in claim 1.

Accordingly, *Torigoe* cannot anticipate claim 1. Claim 1 is thus allowable, and claims 2-15 are also allowable at least due to their depending from claim 1. Independent claims 20 and 22, while of different scope, recites elements similar to those of claim 1 and are thus allowable over *Torigoe* for at least the same reasons discussed above in regard to claim 1. Claim 23 is also allowable at least due to its dependence from claim 22.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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